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EXAMINER
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LOVE, TREVOR M

ART UNIT	PAPER NUMBER
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1611

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/529,264	FERRARI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TREVOR M. LOVE	1611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-129 is/are pending in the application.
- 4a) Of the above claim(s) 68,77-81,92-95,103 and 120-129 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67,69-76,82-91,96-102 and 104-119 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/29/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Acknowledgement is made to Applicant's response filed 11/29/2010.

Claims 67-129 are pending.

Claims 1-66 remain cancelled.

Claims 68, 77-81, 92-95, 103, and 120-129 are withdrawn.

Claims 67, 69-76, 82-91, 96-102, and 104-119 are currently under consideration.

No claims are currently amended.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 11/29/2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### **Maintained Rejections**

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 67, 69-76, 82-91, 96, 97, 101, 102, and 104-119 are rejected under 35 U.S.C. 102(b) as being anticipated by Anton et al (U.S. Patent number 6,153,206, Patent issued Nov. 28, 2000) (IDS reference). This rejection is maintained.**

With regard to **instant claim 67**, Anton teaches a cosmetic composition comprising an oil component and a particulate matter component, wherein the composition further comprises an uncrosslinked synthetic polymer consisting of polymerized ethylenically unsaturated monomers of methacrylate ester monomers (see claim 1). Anton teaches at least two types of monomers, monomer "A" which, if polymerized, would yield a polymer having a glass transition temperature of -10 to 75°C, and monomer "B" which, if polymerized, would yield a polymer having a glass transition temperature of 76 to 120°C (see claim 1). It is noted that when the composition is in the form of the polymer "AAAABBBB" (which is a type of polymer taught in the table in column 4), that both **AAAABBB** and AAAAB**BBB** are block homopolymers, and AAA**ABBBB** is an intermediate random block which comprises at least one constituent monomer from each of blocks A and B. It is further noted that the intermediate random block can also be defined as AA**AABBBB** or AAA**ABBBB**.

It is noted that while Anton is silent as to the percent transfer and the polydispersity index, it is the position of the Examiner that absent evidence to the contrary, the compositions being similar, if not the same, would necessarily have a percent transfer and polydispersity index which are similar, if not the same.

With regard to the dependent claims, it is the position of the Examiner that absent evidence to the contrary, the compositions being similar, if not the same, would necessarily have a percent transfer and solubility which are similar, if not the same, this reads on **instant claims 69 and 70**. Anton teaches the two main blocks have glass transition temperatures (Tg) of -10 to 75°C and 76 to 120°C respectively (see claim 1).

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Said values encompass a plurality of values wherein the difference in (T<sub>g</sub>) values is at least 10°C and block A is less than 20 and block B is greater than 40, this reads on **instant claim 71, 74, 83, 84, and 88**. When said intermediate is defined as AAA**AB**BBB the (T<sub>g</sub>) of the intermediate would necessarily be between (T<sub>g</sub>) values of the A and B blocks, this reads on **instant claim 72**. With regard to the limitation that the first and second blocks are mutually incompatible, it is the position of the Examiner that, absent evidence to the contrary, that since the composition of Anton is similar, if not the same as the instant invention, that both blocks would have the same incompatibility with the oil component as the instant invention. Therefore, since the composition is similar, if not the same, absent evidence to the contrary, it is the position of the Examiner that the composition of Anton meets the limitation of "mutually incompatible" as defined in the instant specification, and therefore reads on **instant claim 73**. The weight proportions of the first (A) and second (B) repeating units in the copolymer can vary from 2-99% by weight of the first repeat unit to 1-98% by weight of the second repeat unit, and vice versa, wherein it is noted that a 50/50 ratio is preferred (see column 5, lines 1-7 and 28-31), this reads on **instant claims 75, 76, and 82**. Said first repeating unit (A) is taught as being methyl methacrylate (see column 5, line 40-44), this reads on **instant claims 85-86**. When said polymer is defined as AAAABBBB, wherein AAA**AB**BBB is an intermediate, both **AAAAB**BBB and AAAAB**BBB** are homopolymers, this reads on **instant claims 87 and 91**. Said second repeating unit (B) is taught as being hexylmethacrylate (see column 5, line 45-48), this reads on **instant claims 89 and 90**. Anton teaches that mixtures of methacrylic acid esters can be

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utilized as either block (A) or (B) (see claims 6-12), this reads on **instant claims 96, 97, 101, and 102**. Anton further teaches that the composition can have a molecular weight of 50,000 (see column 5, lines 30-32), this reads on **instant claims 104 and 105**.

There is no indication in Anton that the composition is required to be an elastomer, this reads on **instant claim 106**. Anton teaches that the copolymer is present as 3-30% of the composition (see column 11, line 10), this reads on **instant claim 107**. Said composition comprises volatile oils, wherein said volatile oil is present in an amount of 10-40% and can be isodecane (see column 6, lines 65-66 and column 11, lines 11-12), this reads on **instant claims 108-110**. Said composition comprises non-volatile oils, wherein said not volatile oil is present in an amount of 10-30% and can be a nonvolatile hydrocarbon (see column 7, lines 43-45 and column 11, lines 13-15), this reads on **instant claims 111-113**. The composition further comprises waxes in an amount of 1-30% (see column 11, lines 16-19), this reads on **instant claims 114 and 115**. The composition of Anton can further comprise pigments (see column 9, lines 28-29), this reads on **instant claim 116**. Said composition can also comprise excipients such as preservatives, antioxidants, vitamins, and emulsifiers (see column 11, lines 5-7), this reads on **instant claim 117**. The composition of Anton can be in the form of an anhydrous stick (see column 2, lines 32-34 and column 11, lines 8-9), this reads on **instant claims 118 and 119**.

#### *Response to Arguments*

Applicant argues in the remarks filed 11/29/2010 that there is not a sound basis for the conclusion that the composition of Anton would possess the PDI and percent

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transfer instantly claimed. Applicant's argument is not found persuasive. The composition of Anton meets all of the structural limitations in the claims, and as such, since a product can not be separated from its properties, the composition of Anton would also necessarily have said properties. It is noted that MPEP 2112.01 states:

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)." Applicant refers to the previously submitted Declaration under 37 CFR 1.132 by Celine Farcet filed 4/22/10 in support that the composition of Anton would not have said properties, however, while evidence is given weight, it is noted that it remains true that a product can not be separated from its properties. Therefore, Applicant's evidence is not found persuasive. It is again noted that the declaration is drawn to a comparison of two polymers made by different method which resulted in different polydispersity indexes. This is not persuasive since Applicant is claiming a product rather than a method, and therefore, the examples in the declaration are not commensurate in scope with the instantly claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 98-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anton et al (U.S. Patent number 6,153,206, Patent issued Nov. 28, 2000) (IDS**



**reference) in view of Hosotte-Filbert et al (U.S. Patent number 5,681,877, Patent issued Oct. 28, 1997) (IDS reference). This rejection is maintained.**

With regard to **instant claims 67 and 96** from which claims 98-100 depend, Anton teaches a cosmetic composition comprising an oil component and a particulate matter component, wherein the composition further comprises an uncrosslinked synthetic polymer consisting of polymerized ethylenically unsaturated monomers of methacrylate ester monomers (see claim 1). Anton teaches at least two types of monomers, monomer "A" which, if polymerized, would yield a polymer having a glass transition temperature of -10 to 75°C, and monomer "B" which, if polymerized, would yield a polymer having a glass transition temperature of 76 to 120°C (see claim 1). It is noted that when the composition is in the form of the polymer "AAAABBBB" (which is a type of polymer taught in the table in column 4), that both **AAAABBB** and AAAAB**BBB** are block homopolymers, and AAA**ABBBB** is an intermediate random block which comprises at least one constituent monomer from each of blocks A and B. It is further noted that the intermediate random block can also be defined as AA**AABBBB** or AAA**ABBBB**. Anton teaches that mixtures of methacrylic acid esters can be utilized as either block (A) or (B) (see claims 6-12)

Anton fails to directly teach that the methyl methacrylate component can comprise blocks of acrylic acid.

Hosotte-Filbert teaches a cosmetic composition for improving wettability of solid particles comprising a block co-polymer which comprises blocks of acrylic (or methacrylic) acid and methyl methacrylate (see claims 1-3), this reads on **instant**

**claims 98 and 99.** Wherein the acrylic acid is present in an amount of less than 50% by weight of the copolymer of acrylic acid and methyl methacrylate (see claim 1), this reads on **instant claim 100.**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the acrylic acid blocks in the methyl methacrylate portion of the block copolymer of Anton. One would have been motivated to do so to allow for improved wetting of the cosmetic composition of Anton. There would be a reasonable expectation of success in the use of acrylic acid and methyl methacrylate since Hosotte-Filbert teaches that said copolymer is useful in cosmetic compositions.

*Response to Arguments*

Applicant argues in the remarks filed 11/29/2010 that Hosotte-Filbert fails to rectify the deficiencies of Anton with regard to the independent claim, specifically with regard to the polydispersity index and the linking segment being a random block, and therefore, the references alone or in combination fail to render obvious the instant invention. Applicant's arguments are not found persuasive since, as identified above, Applicant's arguments with regard to the alleged deficiencies of Anton are not found persuasive.

**Claims 67, 69-76, 82-84, 87-89, 91, 96, 99, 106, 107, 111, 112, 114, and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toniou et al (FR 19730119, translation being relied upon) as evidenced by Aldrich (Reference: Polymer Properties).**

Toniu teaches a cosmetic composition comprising what Toniu terms either a "mixed di-block polymer" represented by formula AAA...AAA-BAB...ABA-BBB...BBB, or a "mixed tri-block polymer" represented by formula AAA...AAA-BAB...ABA-BBB...BBB-CBC...BCB-CCC...CCC (see entire document, for instance, pages 5 and 6). Toniu teaches that the "A" components is selected from the list taught in claim 17, and the "B" component is selected from the list taught in claim 16. It is noted that acrylic acid has a Tg of 105 °C, and n-vinylpyrrolidone has a Tg of 54 °C (as evidenced by Aldrich). It is further noted that lauryl methacrylate (dodecyl methacrylate) has a Tg of -3 °C and lauryl acrylate (dodecyl acrylate) has a Tg of -65°C (as evidenced by Aldrich). It is further the position of the Examiner that absent evidence to the contrary, the compositions being similar, if not the same, would necessarily have a percent transfer and solubility which are similar, if not the same, this reads on **instant claims 69 and 70**. The Tg values of acrylic acid and n-vinylpyrrolidone fall within the range taught for the first block, and the Tg values of lauryl methacrylate (dodecyl methacrylate) and lauryl acrylate (dodecyl acrylate) fall within the range taught for the second block, therefore, since it would be obvious to utilize any one of the components from claim 16 and 17 in combination, said teachings read on **instant claim 71, 74, 83, 84, and 88**. Said intermediate is defined as being "formed by the lipophilic monomer("B")/hydrophilic monomer ("A") copolymer (see claim 10). There is no indication that the intermediate block has any planning or structure to it (i.e. said intermediate block is random). The guidance provided teaches that the intermediate block "is absolutely necessary for providing the connection between the homopolymer block of the first monomer and the

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homopolymer block of the second monomer" (see page 8, lines 4-6), and further that said intermediate blocks are "formed by the lipophilic monomer/hydrophilic monomer copolymer" (see page 14, lines 5-7). Furthermore, since the intermediate block is made up of components "A" and "B" it would necessarily have a Tg value between that of the A and B blocks, this reads on **instant claim 72**. With regard to the limitation that the first and second blocks are mutually incompatible, it is the position of the Examiner that, absent evidence to the contrary, that since the composition of Toniui is similar, if not the same as the instant invention, that both blocks would have the same incompatibility with the oil component as the instant invention. Therefore, since the composition is similar, if not the same, absent evidence to the contrary, it is the position of the Examiner that the composition of Toniui meets the limitation of "mutually incompatible" as defined in the instant specification, and therefore reads on **instant claim 73**. The weight proportions of the first "A" and second "B" repeating units in the copolymer can vary from 20-80% by weight of the first repeat unit to 20-80% by weight of the second repeat unit (see entire document, for instance claim 18), this reads on **instant claims 75, 76, and 82**. Note that when said polymer is a mixed di-block polymer" represented by formula AAA...AAA-BAB...ABA-BBB...BBB components "A" and "B" are homopolymers, this reads on **instant claims 87 and 91**. Said second repeating unit "B" is taught as being lauryl acrylate or lauryl methacrylate (see entire document, for instance, claim 16), this reads on **instant claims 89**. There is no indication in Toniui that the composition is required to be an elastomer, this reads on **instant claim 106**. Toniui teaches that the copolymer is present as 5-50% of the composition (see entire document, for instance, claim 19), this

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reads on **instant claim 107**. Said composition comprises non-volatile oils, specifically, hydrocarbon oils such as solutions of monocrystalline wax (see entire document, for instance, last two sentences of page 14), this reads on **instant claims 111-113**. The composition further comprises waxes (see entire document, for instance, page 15, lines 8-9) wherein said not waxes are exemplified as being present in an amount of 3% which is within the instant claimed range (see page 17, lines 14-20), this reads on **instant claims 114 and 115**.

Toniu fails to directly exemplify that component "A" has a Tg of greater than or equal to 40°C (such as is the case with n-vinylpyrrolidone) and that component "B" has a Tg of less than or equal to 20°C (such as is the case with lauryl acrylate). Toniu also fails to directly teach that the "A" component can comprise a combination of polymers which include acrylic acid.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to create any combination of the lipophilic blocks and hydrophilic blocks as taught by Toniu (see claims 16 and 17). One would have been motivated to do so since first, the combination of said components is taught, and second, there are a limited number of options taught. It is noted that the selection of lauryl methacrylate or lauryl acrylate in combination with the n-vinylpyrrolidone would have been obvious in view of the limited number of components taught.

It further would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a combination of n-vinylpyrrolidone and acrylic acid. One would have been motivated to do so since both components are taught to be useful

for the exact same purpose. It is noted that MPEP 2144.05 states: ““It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992). This renders **instant claims 96 and 99** obvious.

#### *Response to Arguments*

Applicant argues in the remarks filed 11/29/2010 that there is no evidence that the polymers described in Toniui have a PDI of greater than or equal to 2.5 as claimed. Applicant's argument is not found persuasive since the composition of Toniui renders obvious polymers which are structurally identical to those claimed, wherein it is again noted that a product can not be separated from its properties. Therefore, Applicant's argument is not found persuasive. Applicant further argues with *In re Rijckaert* that obviousness cannot be predicted by what is not known at the time an invention is made. Applicant's reliance upon *In re Rijckaert* is not found persuasive since the combination of polymers as directly taught in Toniui was known as the time of Toniui. Therefore, the structural limitations were known at the time of Toniui. The properties of said polymers cannot be separated from said polymers. It is further noted that the above rejection is not based on the obviousness of the PDI, but rather, the obviousness of the combination of polymers which would necessarily have the instant PDI. It is noted that

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MPEP 2112 states “[t]he express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. “The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)”.

**Claims 108-110 and 116-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toniou et al (FR 19730119, translation being relied upon) as evidenced by Aldrich (Reference: Polymer Properties) as applied to claims 67, 69-76, 82-84, 87-89, 91, 96, 99, 106, 107, 111, 112, 114, and 115 and further in view of Anton et al (U.S. Patent number 6,153,206, Patent issued Nov. 28, 2000) (IDS reference).**

The teachings of Toniou as evidenced by Aldrich is set forth above.

Toniou fails to directly teach that the first repeating unit “A” meets the requirements of instant claims 85 and 86 (such as “A” being methyl methacrylate), or that the second repeating unit “B” meets the requirements of instant claim 90. Toniou further fails to directly teach that mixtures of methacrylic acid esters can be utilized as either block “A” or “B” such as in instant claims 97, 101, and 102, or that the composition can have a molecular weight within the range of instant claims 104 and 105, or that said composition comprises the instant volatile oils in the instantly claimed

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amounts of instant claims instant claims 108-110. The composition of Tonui fails to directly identify the presence of pigments (instant claim 116) or excipients (instant claim 117). Furthermore, Tonui fails to directly identify that the composition can be in the form of an anhydrous stick (instant claims 18 and 119).

Anton teaches a cosmetic composition comprising an oil component and a particulate matter component, wherein the composition further comprises an uncrosslinked synthetic polymer consisting of polymerized ethylenically unsaturated monomers of methacrylate ester monomers (see claim 1). Anton teaches at least two types of monomers, monomer "A" which, if polymerized, would yield a polymer having a glass transition temperature of -10 to 75°C, and monomer "B" which, if polymerized, would yield a polymer having a glass transition temperature of 76 to 120°C (see claim 1). It is noted that when the composition is in the form of the polymer "AAAABBBB" (which is a type of polymer taught in the table in column 4), that both **AAAABBB** and **AAAABBBB** are block homopolymers, and **AAAABBBB** is an intermediate random block which comprises at least one constituent monomer from each of blocks A and B. It is further noted that the intermediate random block can also be defined as **AAAABBBB** or **AAAABBBB**. Said composition comprises volatile oils, wherein said volatile oil is present in an amount of 10-40% and can be isodecane (see column 6, lines 65-66 and column 11, lines 11-12), this reads on **instant claims 108-110**. The composition of Anton can further comprise pigments (see column 9, lines 28-29), this reads on **instant claim 116**. Said composition can also comprise excipients such as preservatives, antioxidants, vitamins, and emulsifiers (see column 11, lines 5-7), this



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reads on **instant claim 117**. The composition of Anton can be in the form of an anhydrous stick (see column 2, lines 32-34 and column 11, lines 8-9), this reads on **instant claims 118 and 119**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Toniu and Anton. One would have been motivated to utilize the excipients, pigments, and volatile oil (isodecane) in the form of an anhydrous stick of Anton in the composition of Toniu since said excipients, pigments, volatile oil (isodecane) are known to be useful excipients for cosmetic compositions, particularly lip compositions, as can be seen in Anton. Furthermore, one would have been motivated to use an anhydrous stick since Toniu is directed to a cosmetic, wherein Anton teaches that cosmetics are known to be useful in anhydrous stick form (see Anton, column 2, lines 32-34). There would be a reasonable expectation of success in the combination since both Toniu and Anton are directed to polymeric cosmetic compositions, which have similar compositions. Furthermore, the use of excipients, oils, and pigments are well known in the cosmetic art.

#### *Response to Arguments*

Applicant argues in the remarks filed 11/29/2010 that as discussed above, the references fail to render obvious the instant invention. Applicant's argument is not found persuasive since Applicant's arguments were not found persuasive above.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 67, 70-76, 82-91, 96-102, 104-117, and 119 are directed to an invention not patentably distinct from claims 80, 82, 83, 92, 95, 104, 105, 110, 111, 130, 134-138, 140, 142-157, 160-165 of commonly assigned copending Application No. 10/529218.**

Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are teaching cosmetic composition comprising organic liquid mediums with a non-elastomeric film-forming linear block ethylenic polymer, wherein both compositions further have the same polydispersity index, and blocks with the same glass transitions and made up of the same monomers. The claims differ in how the limitations are presented, however, the instant composition is obvious in view of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 67, 70-76, 82-91, 96-102, 104-117, and 119 are directed to an invention not patentably distinct from claims 77, 79, 80, 84, 87-94, 97-107, 111, 114, 123, 124, 129-131, 150, 154, 155, 157-161 of commonly assigned copending Application No. 10/529266.**

Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are teaching cosmetic composition comprising organic liquid mediums with a non-elastomeric film-forming linear block ethylenic polymer, wherein both compositions further have the same polydispersity index, and blocks with the same glass transitions and made up of the same monomers. The claims differ in how the limitations are presented, however, the instant composition is obvious in view of the copending claims.

Claims 67, 70-76, 82-91, 96-102, 104-117, and 119 are directed to an invention not patentably distinct from claims 80, 82, 83, 92, 95, 104, 105, 110, 111, 130, 134-138, 140, 142-157, 160-165 of commonly assigned copending Application No. 10/529218. Specifically, see above.

Claims 67, 70-76, 82-91, 96-102, 104-117, and 119 are directed to an invention not patentably distinct from claims 77, 79, 80, 84, 87-94, 97-107, 111, 114, 123, 124,

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129-131, 150, 154, 155, 157-161 of commonly assigned copending Application No. 10/529266. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application Nos. 10/529218 and 10/529266, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

#### *Response to Arguments*

Applicant argues in the remarks filed 11/29/2010 that Applicant plans to file an appropriate terminal disclaimer when allowable subject matter is indicated. Applicant's argument is not found persuasive since the rejection has been made of record. As such, the above identified double patenting rejections are maintained.

***Conclusion***

No claims allowed. All claims rejected. No claims objected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/David J Blanchard/  
Primary Examiner, Art Unit 1643